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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/342,789	06/29/1999	DAVID J. CORISIS	3384.1US	7096

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EXAMINER

GRAYBILL, DAVID E

ART UNIT	PAPER NUMBER
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2822

DATE MAILED: 07/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/342,789

Applicant(s)

CORISIS, DAVID J.

Examiner

David E. Graybill

Art Unit

2822

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-39 is/are pending in the application.
- 4a) Of the above claim(s) 20-24 and 33-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-19, 25-32, 38 and 39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 May 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the features of claims 14-19, 25-32, 38 and 39 must be shown or the features canceled from the claims. To further clarify, the drawings do not show the claim 14 embodiment comprising a paddle frame having no narrow common electrical leads for connection to a semiconductor device and paddle support bars, and the claim 27 embodiment comprising a paddle frame having no electrical leads for connection to a semiconductor device and paddle support bars.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not

to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14-19, 25-32, 38 and 39 are rejected under 35 U.S.C. 101 as being non-statutory because they improperly embrace or overlap two different statutory classes of invention, namely, manufacture and process of using the manufacture, which statutory classes are set forth only in the alternative in 35 U.S.C. 101. In particular, claims 14-19, 25-32, 38 and 39 are directed to a manufacture, but the he claims 14 and 27 limitations, "the paddle support bars not used for electrical leads for the semiconductor die," and, "a plurality of paddle support bars that include one of being used as a lead and not being used as a lead," respectively, are directed to a process of using the manufacture.

Also claims 14-19, 25-32, 38 and 39 are rejected under 35 U.S.C. 112, second paragraph, because they are directed to both manufacture and a

process of using the manufacture. As a result, the scope of the claims cannot be determined. See MPEP 2173.05(p)II. Specifically, claims 14-19, 25-32, 28 and 39 are directed to a manufacture, but the claims 14 and 27 limitations, "the paddle support bars not used for electrical leads for the semiconductor die," and, "a plurality of paddle support bars that include one of being used as a lead and not being used as a lead," respectively, are directed to a process of using the manufacture.

Claims 14-19, 25-32, 38 and 39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

The undescribed subject matter is the claim 14 embodiment comprising a paddle frame having, simultaneously, no narrow common electrical leads for connection to a semiconductor device and paddle support bars, and the claim 27 embodiment comprising a paddle frame having, simultaneously, no electrical leads for connection to a semiconductor device and paddle support bars. To further clarify, in the specification, page 6, lines 8-9, applicant discloses that the paddle support bars 24, 28 are electrical leads for connection to a semiconductor die because they are

capable of being used for the intended use as electrical leads for connection to a semiconductor die.

Claims 14-19 25-32, 38 and 39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The undescribed subject matter is the claim 14 embodiment comprising a paddle frame having no narrow common electrical leads for connection to a semiconductor device and paddle support bars, and the claim 27 embodiment comprising a paddle frame having no electrical leads for connection to a semiconductor die and paddle support bars. To further clarify, one skilled in the art would be unable to make a paddle frame having no narrow common electrical leads and paddle support bars, because, as elucidated supra, paddle support bars are inherently narrow common electrical leads.

Claims 14-19, 25-32, 38 and 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 14, the limitation, "a paddle frame having no narrow common electrical leads for connection to the semiconductor die," and "paddle

support bars," are mutually exclusive because, as elucidated supra, the paddle support bars are electrical leads for connection to a semiconductor die because they are capable of being used for the intended use as electrical leads for connection to a semiconductor die.

In claim 14 the scope of the limitation, "the paddle support bars not used for electrical leads for the semiconductor die," is indeterminable because the structure imparted by the limitation is indeterminable. Further, Figures 1 and 1A evidence that the limitation does not structurally limit the claim because Figures 1 and 1A have identical structure.

In claim 27, the limitations, "a paddle frame having no electrical leads for connection to a semiconductor die" and "paddle support bars" are mutually exclusive because, as elucidated supra, the paddle support bars are electrical leads for connection to a semiconductor die because they are capable of being used for the intended use as electrical leads for connection to a semiconductor die.

In claim 27 the scope of the limitation, "a plurality of paddle support bars that include one of being used as a lead and not being used as a lead," is indeterminable because the structure imparted by the limitation is indeterminable. Further, Figures 1 and 1A evidence that the limitation does not structurally limit the claim because Figures 1 and 1A have identical structure.

Claims 1-11 are allowed.

Applicant's amendment and remarks filed and are treated supra.

For information on the status of this application applicant should check PAIR:

Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alternatively, applicant may contact the File Information Unit at (703) 308-2733. Telephone status inquiries should not be directed to the examiner. See MPEP 1730VIC, MPEP 203.08 and MPEP 102.

Any other telephone inquiry concerning this communication or earlier communications from the examiner should be directed to David E. Graybill at (571) 272-1930. Regular office hours: Monday through Friday, 8:30 a.m. to 6:00 p.m.
The fax phone number for group 2800 is (571) 273-8300.



David E. Graybill
Primary Examiner
Art Unit 2822

D.G.
22-Jul-06